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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,836

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Wu-Sung Lee

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09/07/2006

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EXAMINER

WALTER, CRAIG E

ART UNIT

PAPER NUMBER

2188

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/803,836

Applicant(s)

LEE, WU-SUNG

Examiner

Craig E. Walter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-12 are pending in the Application.

Claims 1-12 are rejected.

### ***Response to Amendment***

2. Applicant's amendments and arguments filed on 27 June 2006 in response to the Office action mailed on 5 April 2006 have been fully considered, but they are not persuasive. Therefore, the rejections made in the previous office action are maintained, and restated below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10 rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al (US 5,592,609).

With regard to claim 1, Suzuki et al discloses a method for write-disabling a storage device, said storage device having a storage medium and a firmware [(BIOS) column 9, line 39], said storage device connected to a processing device writing and reading data from said storage medium [(CPU – i.e. processing device) column 9, line 32 –

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Also note the medium itself is the storage area of the disk drive (Fig. 1a (28)), said method comprising steps of:

(a) storing a first parameter in said storage medium, [(attribute information written into attribute memory) column 33, lines 56-57];

(b) receiving said first parameter from said storage medium by said firmware when said firmware receives a write command from said processing device; [(file attribute used for file access) column 27, lines 63-64]. Also note Suzuki teaches the CPU sending a command to the BIOS in order to read information from the ROM, and transfer (i.e. write) it to another location (i.e. floppy drive or RAM). In other words the processor generates the command in order to indicate to the BIOS that instructions must be written (i.e. write command) - col. 9, lines 31-67; and

(c) refusing to execute said write command by said firmware when said first parameter equals a predetermined disable parameter. [(writing is disabled) column 27, lines 66].

With regard to claim 2, Suzuki et al discloses the method of claim 1, wherein said storage medium further comprises a first memory and a second memory, [(floppy disk and flash memory) column 9, lines 60-67].

and said first parameter is stored in said first memory. [(attribute information written into attribute memory) column 33, lines 56-57].

With regard to claim 3, Suzuki et al discloses the method of claim 2, wherein said first memory is a flash memory [(flash memory) column 9, lines 60-67], and said second memory is an SRAM. [(SRAM) column 23, lines 30-36].

With regard to claim 4, Suzuki et al discloses the method of claim 2, wherein said first parameter is included in a message encoded in accordance with Advanced Technology Attachment Programming Interface (ATAPI). [(floppy disk drive) column 3, line 14; (hard-disk drive) column 6, line 60] It is inherent that if internal computer storage is utilized, then ATAPI is the standard interface used for communication of these devices.

With regard to claim 5, Suzuki et al discloses the method of claim 4, wherein said first parameter is stored in said first memory via said second memory. [(attribute information loaded from BIOS into memory) column 32, lines 31-51; Fig. 34 elements 228 & 200]

With regard to claim 6, the method of claim 4, wherein said firmware comprises an updating program, said step (a) comprises steps for storing a first parameter in said first memory and said steps comprise:

(d) receiving said message by said firmware; [(CPU receives output) column 23, line 16];

(e) copying said updating program to said second memory; [(copy access command) column 28, lines 1-7];

(f) executing said updating program in said second memory for storing said first parameter in said first memory; and [(load access command) column 28, lines 1-7]; and

(g) resetting in said first memory. [(reset signal)column 22, line 65]

Claim 7 rejected with same rationale as claim 4.

With regard to claim 8, Suzuki et al discloses the method of claim 7, wherein said predetermined disable parameter is defined by a code for disabling a write function.

(attribute utilized with ID code) column 27, lines 58-59].

With regard to claim 9, Suzuki et al discloses the method of claim 9, wherein said processing device is a personal computer. [(personal computer) column 3, lines 12-14].

With regard to claim 10, Suzuki et al discloses the method of claim 1, wherein said storage device is a disc read/write device. [(hard-disk drive) column 6, line 60].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-12 rejected under 35 U.S.C 103 (a) as being unpatentable over Suzuki et al (US 5,592,609) as applied to claim 10 above, and in view of Kobayashi et al (US 2004/0042363).

As per claims 11 and 12, Suzuki et al does not disclose expressly the method of claim 10, wherein said disc read/write device is a CD-RW or DVD-RW. However, Kobayashi et al discloses utilizing both CD-RWs and DVD-RWs. (page 7, section 0051)

Suzuki et al and Kobayashi et al are analogous art because they are from same field of endeavor, namely write-disabling storage devices. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the CD-RWs and DVD-RWs of Kobayashi et al into the system of Suzuki et al. The motivation for doing so would have been to effectively protect various kinds of data (Suzuki et al; page 2, section 0006).

### ***Response to Arguments***

5. Applicant's arguments with respect to claim s 1-12 have been considered but are not persuasive.

As for claim 1, Applicant outlines four specific arguments with respect to claim 1 as contrasted with Suzuki's teachings. Those arguments are not found to be persuasive for the following reasons:

As for Applicant's first argument with respect to claim 1, is the current Examiner's belief that Applicant misinterpreted the previous Examiner's mapping of a few critical elements recited in claim 1 with elements as disclosed by Suzuki. For example, Applicant asserts that the previous Examiner argued the CPU as being the storage medium as per section four of the previous office action ("said storage device connected to a processing device writing and reading data from said storage medium [(CPU) column 9, line 32]."), however it is clear to the present Examiner that the CPU referenced in column 9, line 32 was cited to refer to the processing device, which is connected to the storage medium as per recited in this claim. Furthermore, it is the

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current Examiner's understanding that the storage medium itself is the disk used to store data (element 28, Fig. 1a). Applicant contends that Suzuki fails to teach a storage medium having a storage medium and a firmware because each of these elements are located on the outside of the console. This argument is not persuasive as the current Examiner maintains that though the firmware (BIOS – Fig. 2a, element 234) and the medium (the physical storage area of the hard disk – element 28 of Fig. 1) are separately located, they are constituent parts of the larger storage device (the system of Fig. 1a, which serves, *inter alia*, as a means to store data).

In the second argument with respect to claim 1, Applicant contends that Suzuki fails to teach “a method for write-disabling a storage device”. Examiner maintains that such a statement is merely a method *for* (emphasis added) write-disabling a storage device, and hence appropriate patentable weight has been given to the given to the preamble of this claim in the rejection set forth *supra*. According to MPEP § 2111.02, “If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction”.

It is the Examiner's contention that Applicant's recitation of a method for write disabling does not in fact “breathe life and meaning into the claim” as it merely states the purpose of said method. More specifically, the three steps positively recited in this claim are not necessarily unique to a method for write-disabling a storage device.



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Therefore, Applicant's second argument is not persuasive as the claim is not rendered patentable distinct over Suzuki merely in view that Suzuki's intended use allegedly differs from the use of the present invention.

As for the third argument, Applicant contends that Suzuki fails to teach the processing device writing and reading data from said storage medium. As stated above, it is of the present Examiner's belief that Applicant misinterpreted the previous Examiner's rejection with respect to the processing device (the processing device is in fact the CPU). Applicant's argument that Suzuki fails to teach the processing device as writing and reading data from the medium is found to be not persuasive as all storage mediums (including the one taught by Suzuki) must inherently be read from, and written to by some sort of processing unit or device.

As for Applicant's forth argument, Applicant contends that Suzuki fails to teach the firmware as receiving a write command from said processing device". Applicant further asserts that Suzuki fails to teach the BIOS as receiving a write command. Suzuki however teaches the CPU sending a command to the BIOS in order to read information from the ROM, and transfer (i.e. write) it to another location (i.e. floppy drive or RAM). In other words the processor generates the command in order to indicate to the BIOS that instructions must be written (i.e. write command) - col. 9, lines 31-67.

Applicant's argument that Kobayashi fails to cure the alleged deficiencies of claim 1 is rendered moot as Examiner maintains that claim 1 remains rejected under 35 USC § 102(b) per the rejection and arguments presented *supra*.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

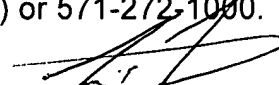
7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig E. Walter whose telephone number is (571) 272-8154. The examiner can normally be reached on 8:30a - 5:00p M-F.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571) 272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Craig E Walter  
Examiner  
Art Unit 2188

CEW

  
8/28/06

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